

REMARKS

Claims 1-17 are pending in this application. Claims 1 is the only independent claim. By this amendment, the specification is amended. Reconsideration in view of the above amendments and following remarks is respectfully solicited.

The Double Patenting Rejection is Obviated

The office Action rejects claims 1 and 17 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4, respectively, of U.S. Patent No. 6,473,198 in view of Okamoto (US 5,475,509). This rejection is respectfully traversed.

Applicant respectfully submits that a Terminal Disclaimer in compliance with 37 CFR 1.312(c) is filed herewith.

As such, withdrawal of the rejection under the judicially created doctrine of obviousness-type double patenting is respectfully requested.

The Claims Define Patentable Subject Matter

The Office Action rejects: (1) claims 1, 2, 12 and 17 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,285,398 to Shinsky et al. (hereafter Shinsky); (2) claims 3-5 and 7 under 35 U.S.C. §103(a) as being unpatentable over Shinsky in view of U.S. Patent No. 6,188,432 to Ejima (hereafter Ejima); (3) claims 6 and 11 under 35 U.S.C. §103(a) as being unpatentable over Shinsky in view of U.S. Patent No. 4,973,149 to Hutchinson (hereafter Hutchinson); (4) claims 8, 9, 14 and under 35 U.S.C. §103(a) as being unpatentable over Shinsky in view of Japanese Patent

407074943A to Nakamura; and (5) claims 10, 13 and 16 under 35 U.S.C. §103(a) as being unpatentable over Shinsky in view of Ejima and further in view of Nakamura.

These rejections are respectfully traversed.

Shinsky fails to be Prior Art

Applicant respectfully submits that Shinsky fails to qualify as prior art.

For example, the present application claims the right of priority based on Japanese Application No. JP 9-243726 filed September 9, 1997. As such, applicant's priority document predates the effective filing date of the Shinsky reference by more than two months, i.e., November 17, 1997.

As such, applicant hereby perfects the claim to priority under 35 USC 119 by filing herewith an English language translation of the priority document JP 9-243726.

As a result, Shinsky no longer qualifies as prior art. Accordingly, withdrawal of the rejection of claims 1, 2, 12 and 17 under 102(e) as being anticipated by Shinsky is respectfully requested.

Ejima, Hutchinson, and Nakamura all fail to make up for the disqualification of Shinsky

Applicant respectfully submits that with the disqualification of Shinsky, the remaining secondary references, Ejima, Hutchinson and Nakamura, must make up for the disqualification of Shinsky by teaching or suggesting each and every feature as set forth in claims 3-11 and 13-16.

However, Applicant respectfully submits that Ejima, Hutchinson and Nakamura all fail to make up for the disqualification and/or deficiencies found in Shinsky.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicant respectfully submits that with the disqualification of Shinsky, the secondary references, Ejima, Hutchinson and Nakamura, all at least fail to teach or suggest setting corrected image processing conditions primarily based on the information about the at least one principal part of the image designated, as set forth in independent claim 1.

As such, applicant respectfully submits that independent claim 1 is allowable over Ejima, Hutchinson, and Nakamura, either alone or in combination, for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claim, and/or

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for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1-17 under 35 U.S.C. §102(e) and §103(a) is respectfully requested.

Conclusion

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.


Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 to schedule a Personal Interview.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

Respectfully submitted,
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Attachment(s):

Terminal Disclaimer
English language Translation Of Priority Document